

REMARKS

The Examiner is thanked for indicating that claim 11 is allowable if rewritten in independent form.

Claims 1, 2, 4-15, 17-20, 22-25, and 27-29 remain pending in the instant application. Claims 1, 2, 4-10, 12-15, 17-20, 22-25, and 27-29 presently stand rejected. Claim 11 is objected to. Claims 1, 10, 12-15, 17-19, and 25 are amended herein. Claims 3, 11, 16, 21, and 26 are hereby cancelled without prejudice. Entry of these amendments and reconsideration of the pending claims are respectfully requested.

Claim Rejections – 35 U.S.C. § 112

Claims 12-15, 17, and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action states, “Claims 12-15, 17, and 18 recite a ‘machine-readable storage medium.’ The original specification does not disclose a machine-readable storage medium, thus the claims recite new matter.” *Office Action* mailed 9/8/08, page 2.

“In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims...” MPEP § 608.01(L). “If the examiner concludes that the claimed subject matter **is not supported [described] in an application as filed**, this would result in a rejection of the claim on the ground of a lack of written description under 35 USC 112, first paragraph... **The claim should not be rejected or objected to on the ground of new matter.**” MPEP § 2163.01 (emphasis added). “Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits...” MPEP § 608.01(L).

Applicants note that the language “machine-readable storage medium” was part of the “original” claim 12, and therefore, was part of the application “as filed.” As such, this language cannot constitute “new matter,” pursuant to MPEP § 2163.01. Furthermore, since this language was described in the application “as filed” (i.e., part of original claim 12), 37 CFR § 112, first paragraph does not present a valid basis for rejecting claim 12, pursuant to MPEP § 608.01(L).

Claim Rejections – 35 U.S.C. § 101

Claims 12-15, 17, and 18 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory matter.

Claim 12 has been amended to recite, “A **processor**-readable **storage** that **stores** instructions, which when **executed** by a **processor**, will cause the processor to perform operations comprising...” (emphasis added). This claim style is a typical and permissible Beauregard style pursuant to *In re Beauregard*.

Furthermore, the specification provides adequate written description support for the amended language. In particular, the specification states,

In one embodiment, functionality for performing operations corresponding to the process and decision blocks illustrated in FIG. 3 are **stored** within NV **storage** 515 and **executed** by **processor** 505.

Detailed Description, para. [0043], (emphasis added). The flow chart illustrated in FIG. 3 provides written description support for the body of claim 12 and the cited language states that the process and decision blocks illustrated in FIG. 3 can be “stored” in a “storage” and are “executed” by a “processor.”

Accordingly, the Applicants respectfully request that the instant § 101 rejections be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 19, 20, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pearson (US 5,477,364). Claim 25 stands rejected under 35 U.S.C. § 102(a) as being anticipated by Ovadia (US Patent Publication 2003/0198471).

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the claim.” M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

Independent claim 19 has been amended to include subject matter similar to the subject matter of dependent claim 11 (now cancelled) deemed allowable by the Examiner. Accordingly, independent claim 19 now includes allowable subject matter.

Independent claim 25 has been amended to include subject matter similar to the subject matter of dependent claim 11 (now cancelled) deemed allowable by the Examiner. Accordingly, independent claim 25 now includes allowable subject matter.

Consequently, Pearson and Ovadia fail to disclose each and every element of independent claims 19 and 25, as required under M.P.E.P. § 2131. Accordingly, Applicants respectfully request that the instant § 102 rejections of independent claims 19 and 25 be withdrawn.

The dependent claims are novel and nonobvious over the prior arts of record for at least the same reasons as discussed above in connection with their respective independent claims, in addition to adding further limitations of their own. Accordingly, Applicants respectfully request that the instant § 102 rejections of the dependent claims be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 4-10, 12-15, 17, 18, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ovadia in view of Westberg (US Patent Publication 2003/0198226). Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pearson in view of Ovadia. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pearson in view of Westberg. Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ovadia.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03.

Independent claim 1 has now been amended to include subject matter of dependent claim 11 (now cancelled) deemed allowable by the Examiner. Accordingly, claim 1 now includes allowable subject matter.

Independent claim 12 has been amended to include subject matter similar to the subject matter of dependent claim 11 (now cancelled) deemed allowable by the Examiner. Accordingly, independent claim 12 now includes allowable subject matter.

Consequently, the prior art of record fails to disclose each and every element of claims 1 and 12, as required under M.P.E.P §2143.03. Accordingly, withdrawal of the instant §103 rejections of independent claim 1 and 12 is requested.

The dependent claims are nonobvious over the prior art of record for at least the same reasons as discussed above in connection with their respective independent claims, in addition to adding further limitations of their own. Accordingly, Applicants respectfully request that the instant § 103 rejections of the dependent claims be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 292-8600 if the Examiner believes that an interview might be useful for any reason.

CHARGE DEPOSIT ACCOUNT

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a). Any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666. Please credit any overpayment to the same deposit account.

Respectfully submitted,

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